

No. 231.

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

OCTOBER TERM, 1894.

JOHN HAMMOND,
Plaintiff in Error,
VS.

STOCKTON COMBINED HARVESTER AND
AGRICULTURAL WORKS,
Defendant in Error.

Reply Brief of Plaintiff in Error.

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REPLY BRIEF OF PLAINTIFF IN ERROR.

I.

THE FIRST POINT MADE BY DEFENDANT IN ERROR IS THAT THE PATENT IN SUIT IS VOID, BECAUSE ITS SUBJECT-MATTER IS NOT PATENTABLE AS A DESIGN, BUT ONLY AS A MECHANICAL DEVICE, IF AT ALL.

In other words, it is contended that under the Design Patent Act a patent cannot be granted for the *shape* or *form* of an article. The learned counsel cites no authority for such position, but contents himself with the assertion that this patent is an *anomaly*, and that "in a thirty years' experience of close intimacy with patents and the Patent Office," he (the said counsel) "has never met with a similar case."

In answer to this argument, we will not be so unkind as to say to the learned counsel what Hamlet is reported to have said to Horatio, but we do venture to repeat the homely adage, "It is never too late to learn."

Our reply to the point is as follows:

First. It is answered conclusively by the wording of the statute.

By section 4929 of the revised statutes it is provided *inter alia* that a design patent may be issued for "any new, useful and original *shape or configuration* of any article of manufacture, etc."

This covers the case in hand. Our car-body is a new, useful and original shape or configuration."

Under this statute design patents have been issued for the shape of a *saddle* (*Smith vs. Whitman Saddle Co.*, 148 U. S., 675); for the form and shape of a corset (*Kraus vs. Fitzpatrick*, 34 Fed. Rep., 39); for the form and shape of an ink-stand (*Ex parte Soloman*, Com. Decs. of 1869, p. 49); for the shape and form of a rubber eraser (*Ex parte Bartholomew*, Com. Decs. of 1869, p. 103); for the form of a damper for stovepipes (Coms. Decs. of 1871, p. 52); for the shape of a clock case (Com. Decs. of 1871, p. 106); for the shape and form of spoon handles (*Gorham vs. White*, 14 Wall., 511); for the shape and form of a newel post (*Simpson vs. Davis*, 12 Fed. Rep., 144); for the shape and form of glass bottles and jars (*Ripley vs. Elson Glass Co.*, 49 Fed. Rep., 927); for the form and configuration of a door mat (*Belting Co. vs. Car Co.*, 48 Fed. Rep., 556; 53 *Id.*, 811).

Commissioner Butterworth expressed the true doctrine in *Ex parte Traitel* (25 O. G., 783), by saying: "A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The construction of an article in accordance with that delineation is the materialization of the conception of the design. The

conception of a building of some particular shape, form or configuration, and which is delineated on paper, or described in language, is a design. The various *shapes* and *figures* which appear in colors on the surface of prints and carpets are expressions of so many different designs. The material out of which the building is constructed, whether of stone, brick, wood or glass forms no part of the design. The colors in which they find expression are of no possible importance in describing the design itself. A combination of red and blue and green may be beautiful and the effect very desirable, but it forms no part of the design, but is the medium through which a design, which relates solely to form and configuration, finds expression or materializes. Then since a design as used in the statute relates *solely to form and configuration*, how should it be described?"

Second. The point raised is foreclosed by the findings of the lower court, and cannot be raised on this appeal.

In its findings of fact the lower court found: "That * * * John Hammond, by his own industry, genius, efforts and expense, conceived, devised and produced a new and original design for a manufacture, to wit: a new, useful and original shape and configuration of a car-body; that the same consisted and does consist of a car-body distinguished by its peculiar shape and configuration. * * * That the said design had not been known or used by others before the conception, devising and production thereof by said plaintiff, nor patented nor described in any printed publication; nor had the same been in use in this country for two years prior to the application for a patent, etc. * * * That * * * letters

patent of the United States were issued and delivered to plaintiff for said design; * * * that said letters patent were issued in due form of law, etc.; * * * that prior to the issuance of said letters patent all proceedings were had and taken in the Patent Office which are required by law to be had and taken prior to the issuance of letters patent for designs" (Record, 20-1-2).

These findings of the lower court are unchallenged. They determine that the shape and form of a car-body are within the law of design patents. They determine further that this particular shape and form of a car-body is "a new and original design for a manufacture," following the exact words of the statute. This cannot now be questioned, and that point is conclusively settled. The sole and only question open is as to the amount of invention, if any, displayed in producing that design. That was the sole ground of the decision below, because every other issue was found in favor of the plaintiff in error. Hence the point raised by defendant in error, that the shape of a car-body is not within the law of design patents, cannot be raised.

II.

THE SECOND POINT MADE IS THAT AS HIGH A DEGREE OF INVENTION IS REQUIRED IN DESIGN AS IN MECHANICAL PATENTS.

The first case cited by defendant, *Cahoon Barnett Mfg. Co. vs. Rubber and Celluloid Harness Co.* (45 Fed., 582), decides no such doctrine. The patent was held void because the design was found to be "identical" with at least four prior designs patented by other persons (See page 586 of the case, bottom paragraph). That was the

ground of the decision, and anything beyond that is *dictum*. The quotation from the case found at page 8 of counsel's brief is not correct. It omits a sentence which changes the entire meaning of the quotation as given. Your Honors will readily see this by referring to the case. We have not time to dwell on it, but must hurry on.

The second case cited is *Western Electric Co. vs. Odell* (18 Fed. Rep., 321), decided by Judge Blodgett. In that decision the learned Judge quotes from *Simonds on Design Patents*, the extract appearing on page 8 of counsel's brief. The patent there was held void for want of novelty, and we submit that the quotation from Simonds was *dictum*. It was not necessary to the decision of the case. At any rate Judge Blodgett in the same case cites with approval the case of *Gorham vs. White* (14 Wall., 511), and it is on the authority of that case that we claim a reversal herein.

The third case cited is *Northrup vs. Adams* (2 B. & A., 597). It decides merely that: "Design patents are subject to the *general principles* of construction applicable to mechanical patents." It does not touch the point in issue here.

Counsel next cites *New York Belting and Packing Co. vs. New Jersey Car-Spring and Rubber Co.* (30 Fed. Rep., 785), but why he does so we are at a loss to conceive. In that case the lower court on demurrer held the patent void for want of invention; but on appeal the Supreme Court held this to be error and reversed the decree, and directed a trial on the merits. (Same case, 137 U. S., 445).

The case was then tried in the lower court, resulting in

a decree sustaining the patent. (Same case, 48 Fed. Rep., 556.)

On appeal from this decision to the Court of Appeals the patent was again sustained, but it was decided that no infringement had been shown. (Same case, 53 Fed. Rep., 810.)

The case of *Wooster vs. Crane* (5 Blatch., 282), cited at page 9 of brief, decides nothing contrary to our views.

The same may be said of the next case cited, *F. G. & W. F. Neideringhaus* (8 O. G., 279). The quotation alone (given at page 10) is sufficient to sustain our view. It merely holds that "the same degree of *originality* is required in both design and functional patents." And this is explained as meaning that "the claim must not be for a copy or imitation of what is already in existence."

Nothing is said about *invention*. Originality refers to *novelty*, not to *invention*, and here the lower court found that our design was "new, useful and *original*," which finding is not attacked on this appeal.

This disposes of all the cases cited by counsel to the point that the same degree of invention is required in designs as in mechanical patents. We submit that they establish no such doctrine, and that the views advanced in our opening brief on this point are correct.

III.

IT IS NEXT INSISTED BY COUNSEL FOR DEFENDANT IN ERROR THAT THE PATENT IS VOID BECAUSE,

- 1st. *It displays a mere duplication of an old device.*
- 2d. *It is a case of mere double use.*

As to the first contention, the cases of *Dunbar vs. Meyers* (94 U.S., 197), *Millner vs. Voss* (4 Hughes, 262),

Stevenson vs. Brooklyn Cross-Town Railroad (14 Fed. Rep., 461 and 114 U. S., 156), *Tack Co. vs. Two Rivers Mfg. Co.* (109 U. S., 119) are cited.

In *Dunbar vs. Meyers* the patentee merely placed a *second* deflecting plate on a circular saw when the use of *one* such plate was already known, and he thereby secured merely a *double* effect. No new effect at all was produced.

In *Millner vs. Voss* the same principle was involved as to the use of a second or a double fire place. An *increased* old result was produced, but no *new result*.

The remaining cases cited are to the same effect. We admit that *mere* duplication is not patentable (in mechanical devices), and by that is meant the mere doubling of an old device, which merely doubles or increases the old effect, but produces no new effect. If one horse can draw a ton, it is a logical deduction that when a second horse of the same capacity is added, the two combined can draw two tons. If one locomotive can draw six cars, two locomotives can draw twelve. If one man can do a piece of work in two days, then two men can do it in one day. If one deflecting saw plate can do a certain amount of deflecting, then two such plates will do twice as much (*Dunbar vs. Meyers*). If one fire-place produces a certain degree of heat, two such fire-places will produce twice as much (*Millner vs. Voss*). *Two* bell straps in a street car have double the pulling capacity of *a single one* (*Stevenson vs. R. R. Co.*) These are mere mathematical problems. They involve logic and reasoning (and very little even of that), but no inventive faculty. Hence, they were not patentable.

But where duplication does something more than increase or intensify an old result, *where it produces a new and useful result*, it is patentable. It is a difference between *degree* and *kind*. Difference in *degree* is not patentable; difference in *kind* is. This distinction is settled by *Parker vs. Hulme* (1 Fish., 44); *Wilbur vs. Beecher* (2 Blatch., 132), and *Barnes vs. Straus* (9 Blatch., 553).

That our design does produce a new and useful result, differing in kind from any ever before produced, and not being an obvious one, is clear from the testimony, *and is found as a fact by the lower court*. That finding is not attacked by any one, certainly not by us, and as the defendant has not appealed, it stands conceded on this appeal. We therefore say that it follows as an unerring conclusion that this design is patentable.

Second. As to counsel's so-called double use.

An attempt is made in defendant's brief to place our design in the category of *double use*.

The attempt is futile. *Double use* in patent law means simply *the mere application of an old contrivance to a new use*. Instances are these: Using a spoon to eat peas with, which had formerly been used to eat soup with (*Losh vs. Hague*, 1 Webs., 202); using a mill for grinding corn, which formerly had been used for grinding coffee, or a cotton-gin for cleaning hemp, or a woolen yarn loom for weaving cotton yarns (*Bean vs. Smallwood*, 2 Robb, 133); using an umbrella to ward off the sun, which had been formerly used to ward off rain, or using a bread knife to cut meat with (*Strong vs. Noble*, 3 Fish, 586); mounting stereoscopes on tripods when theodolites and telescopes had been before so mounted (*Sawyer vs. Byx-*

bee, 9 Blatch., 361); using in a horse car a pole formerly used in carriages and wagons (*Proctor vs. Brill*, 4 Fed. Rep., 419); using in a lime kiln furnace, a device formerly used in a quicksilver furnace (*Knox vs. Quicksilver Mining Co.*, 4 Fed. Rep., 809); using a certain method for preserving fish formerly used for preserving human corpses (*Brown vs. Piper*, 91 U. S., 37); using under locomotives a swivelling truck formerly used under cars (*Pennsylvania R. R. Co. vs. Locomotive Safety Truck Co.*, 110 U. S., 490).

Numerous cases on this point will be found collected and commented on by Mr. Justice Brown in the recent case of *Potts vs. Creager* (155 U. S., 606-7). We also call especial attention to that authority as one laying down certain rules for determining the presence of invention in cases of doubt, and it may assist your Honors materially herein.

The true meaning of *double use* in patent law will be seen from the above citations. It is radically different from *duplication*, and bears no analogy to anything in this case. Evidently the learned counsel did not give the subject much discriminating thought, but was led astray by the mere sound of the words. Hammond's design is undoubtedly a case of *duplication* of an old dummy (which, however, produces a new result, and is therefore patentable), but certainly it has no semblance whatever to a *double use*, which is the mere application of an old thing to a new use.

The last point made by defendant's counsel is the assertion that the case of *Smith vs. Whitman Saddle Co.*

(148 U. S., 675), settles the question that no invention is involved in the Hammond design.

That case decided nothing of the kind. The decision went off on the question of *infringement*. It does, however, hold that a design patent may issue for the *form, shape or configuration* of an article, and it refers to the former case of *Gorham vs. White* on which we rely.

Respectfully submitted,

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